



PATENT APPLICATION

*REC'D 11/9
SEP 19 2001 12/1/01
TECH CENTER 1600/2900*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Esswein et al.

Group: 1626

Serial No. 09/675,943, filed September 29, 2000

Examiner: L. Stockton

**For: OSTEOBLAST-SPECIFIC MITOGENS AND DRUGS CONTAINING SUCH
COMPOUNDS**

COMMUNICATION

**Nutley, New Jersey 07110
September 13, 2001**

**Commissioner of Patents
Washington, D.C. 20231**

Dear Sir:

This Communication is filed in response to the August 16, 2001 Office Action issued in connection with the above-identified patent application. A response to this Office Action is due September 15, 2001.



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TRANSMITTAL FORM

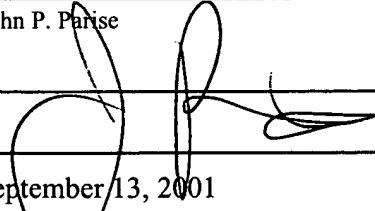
(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/675,943
	Filing Date	September 29, 2000
	First Named Inventor	Angelika Esswein
	Group Art Unit	1626
	Examiner Name	L. Stockton
Total Number of Pages in This Submission	Confirmation Number	

ENCLOSURES (check all that apply)

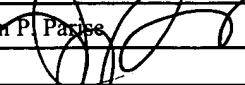
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund <div style="border: 1px solid black; padding: 2px; margin-top: 5px;">Remarks</div>	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Additional Enclosure(s) (please identify below): <div style="border: 1px solid black; height: 40px; margin-top: 5px;"></div>
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	John P. Parise
Signature	
Date	September 13, 2001

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231:

Typed or printed name	John P. Parise	Date
Signature		September 13, 2001

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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In the Office Action restriction was required under 35 U.S.C. § 121. Specifically, there are allegedly two independent and distinct groups of inventions. Group I includes claims 7 and 21-23, wherein X is oxygen. Group II includes claims 7, 23 and 24 wherein X is an H.

In response to this restriction requirement, applicants elect, with traverse, to → prosecute at this time the invention of Group II, claims 7, 23 and 24, wherein X is NH.

Applicants traverse this restriction since it would not be a serious burden on the Examiner to search all of the claims at this time.

Applicants were required under 35 U.S.C. § 121 to elect a single disclosed species for searching purposes. Applicants traverse the election requirement because the Patent Office is required as a matter of law to examine on the merits the entirety of the generic claims (see below).

Procedures for making an election of species are described in MPEP 809.02 and 37 C.F.R. §1.146. Under 37 C.F.R. §1.146, the Patent Office may "require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted **if no claim to the genus is found allowable**" (emphasis added). Once a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed. MPEP 809.02(e). Therefore, the Patent Office should not have required election under 35 U.S.C. § 121 until a determination of patentability was made with respect to the generic claims.

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Whether the claimed species are patentably distinct is irrelevant to the determination of patentability of applicants' claims directed to the elected species and the generic claims that read on these species. Unless all generic claims have been rejected, no question of patentability arises with regard to the non-elected species. In view of the limited number of species claimed in the present application, examination of each and every species on the merits should follow allowance of the generic claims.

In re Wolfrum and Gold, 179 USPQ 620, 622 (CCPA 1973) addresses the examination of claims in the context of rejection made under 35 U.S.C. § 112, "the scope of the subject matter is governed not by the examiner's conception of the 'invention' but by that 'which the applicant regards as his invention'.... applicant is free under that provision to set the metes and bounds of 'his invention' as he sees them..... Thus a determination by the Patent Office that earlier, separate claims encompass a 'plurality of different inventions' cannot serve, under § 112, as the basis for a rejection of a later combined claim....the rationale of the rejection also encompasses the provisions and mandate of 35 U.S.C. 101 and 121 (emphasis in original text)."

Applicants are entitled to a complete action on the merits of all claims, including those readable on the elected species, i.e. claims 7 and 23. Failure of the Patent Office to consider such claims in their entirety would be tantamount to a rejection and appealable. *In re Hass*, 179 USPQ 623, 627 (CCPA 1973) the court stated that "An examiner's adverse action of this nature *is* a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board" (emphasis in original text).

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It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978) at pages 331-332,

“§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be “independent and distinct.” It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject a particular claim* on that same basis.” (Emphasis in original text).

Applicants have the right to claim their invention as they deem appropriate, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold* at 622.

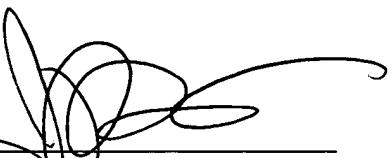
→ The above being stated, applicants select the species *cis*-9-octadecenoic acid-2-hydroxy-3-phosphonoxypropylamide. This compound is described on page 22 of the specification in Example 2.

If a telephone conference would be of assistance in furthering prosecution, applicants request that the undersigned attorney be contacted at the number below.

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No fee is required in connection with the filing of this Communication. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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